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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,900	11/06/2001	Glen R. Cataline	47004.000115	4559

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,900

Applicant(s)

CATALINE ET AL

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/17 9/10 4/23-25</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-41 are pending. The rejection is as stated below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 21 and 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 49 and 51 of copending Application No. 10/175,031. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

In reference to instant claim 1, this claim recites inputting first information regarding at least one payment source; and second information regarding at least one payment account; and a

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processor, the processor selectably directing a transmission of funds from the at least one payment source to the at least one payee account based on an optimization determination. Claim 1 of the '031 Application recites a processor that determines the payment mechanism based on a payment source, a payment account and an optimization determination. The instant claim 1 does not include all the limitations of claim 1 of the '031 Application. Instant claim 1 does not include information regarding a data input portion that inputs information regarding a payment request, a decision reference data store for storing information regarding parameters for determining a payment mechanism, and a processor, which is in communication with both the data input portion and the decision reference data store. regarding the detail of the equipment for enabling and disabling. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Claims 21 and 41 contain similar limitations as that of claim 1 and thus follow similar reasoning.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-40 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the preamble or the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

A suggested amendment to the preamble would be: "A computer implemented method for managing transactions" or something similar.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. (hereinafter Dent) U.S. Patent 6,128,603 in view of Boesch et al. (hereinafter Boesch) U.S. Patent 6,205,433.

Regarding independent claims 1, 21 and 41, Dent teaches a system for managing transactions comprising:

a first interface for communicating first information regarding at least one payment source (column 7, lines 3-25);

a second interface for communicating second information regarding at least one payee account (column 7, lines 26-33 and column 7, lines 56 thru column 8, line 2 and Figure 4 and Figure 5);

a processor, communicating with the first interface and the second interface, the processor selectably recommending a transmission of funds from the at least one payment source to the at least one payee account based on an optimization determination (column 5, line 53 thru column 6, line 8 and Figure 2 and column 9, lines 27-31 and column 10, lines 1-14).

Dent teaches that the optimization provides a recommendation to the customer to manage cash flows. Dent fails to teach that the processor directs the transmission of funds. Boesch teaches a system and method for multi-currency transactions in which an optimization may be performed to determine whether it is advantageous for customer user to pay in one customer currency over another (column 11, lines 33-36). Boesch further teaches that the customer computer is programmed to choose the currency conversion method that optimizes the transaction without reducing the options available to the customer user (column 11, lines 37-62). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dent and include the optimization teachings of Boesch because it provides a way to minimize cost and optimize cash flows without limiting the user's transaction options.

Claims 2 and 22, the optimization determination comprises a calculation of at least one payment source data, payee account data, payment schedule data, payment type data and privacy data (column 9, lines 27-31 and column 10, lines 1-14).

Claims 3 and 23, wherein the at least one payment source comprises a calculation of at least one of a direct deposit account, a source credit account, a mortgage account, a securities account, a money market account, a micro payment account, an overdraft account and a stored value account (column 9, lines 27-31 and column 10, lines 1-14).

Claims 4 and 24, the at least one payee account comprises at least one of a utility account, a mortgage account, a payee credit account and a contribution account (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Claims 5 and 25, a storage module, communicating with the processor, the storage module storing at least one of the data on the optimization determination, data on the at least one payment source account, and data on the at least one payee account (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Claims 6 and 26, wherein at least one of the first interface and the second interface comprises a telephone connection (column 4, line 59 thru column 5, line 3).

Claims 7 and 27, wherein at least one of the first and the second interface comprises a network connection (column 4, line 59 thru column 5, line 3).

Claims 8 and 28, the network connection comprises a remote client from which a user may communicate transaction instructions (column 4, line 59 thru column 5, line 3).

Claims 9 and 29, the remote client comprises at least one of a computer, a network-enabled cellular telephone, a portable digital assistant, a paging device, and a set-top box (column 4, line 59 thru column 5, line 3).

Claims 10 and 30, the user comprises at least one of a consumer, a business entity and a government entity (column 3, lines 6-26).

Claims 11 and 31, wherein at least one of the first interface and the second interface comprises a desktop graphical user interface directly communicating with the processor (column 5, lines 19-63).

Claims 12 and 32, wherein the processor performs an optimization on a transaction carried out according to the transaction instructions (column 9, lines 27-31 and column 10, lines 1-14).

Claims 13 and 33, the optimization comprises at least one of minimizing a cost variable, fulfilling a transaction schedule, minimizing a payment penalty, maximizing a float of the at least one source account, ensuring an affiliation between the payment source and the payee account, maximizing security, maximizing reliability, minimizing risk, fulfilling a contractual obligation, maximizing volume discounts, aggregating a transaction amount, maximizing a transaction amount and maximizing available bonus awards (column 9, lines 27-31 and column 10, lines 1-14).

Claims 14 and 34, wherein the optimization comprises minimizing a cost variable, and the cost variable comprises at least one of a transaction cost charged to a payment initiator and

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an internal cost absorbed by a payment enabler (column 9, lines 38-60 and column 10, lines 1-14).

Claims 15 and 35, the optimization determination comprises utilization of third party association and payment providers (column 5, line 53 thru column 6, line 8).

Claims 16 and 36, wherein members of the third party associations are systematically identified by at least one of real time calls to the third party associations, and real time calls to a datastore containing third party association member data which is periodically updated (column 5, line 53 thru column 6, line 8).

Claims 17 and 37, the optimization determination comprises a systematic identification and internal settlement for closed loop payments in which the payment source and the at least one payee account reside within one entity (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Claims 18 and 38, wherein an expense reduction resulting from optimization of the cost variable is realized by at least one of the payment enabler and the payment initiator (column 9, lines 27-31 and column 10, lines 1-14).

Claims 19 and 39, wherein a payment initiator is presented with at least two mechanisms that meet the payment schedule data and associated costs of the at least two mechanisms, and the

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payment initiator is permitted to manually choose an optimal method of transfer (column 10, lines 15-20).

Claims 20 and 40, Dent fail to teach that the transmission comprises a currency conversion. Boesch teaches that the customer computer is programmed to choose the currency conversion method that optimizes the transaction without reducing the options available to the customer user (column 11, lines 37-62). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dent and include the optimization teachings of Boesch because it provides a way to minimize cost and optimize cash flows without limiting the user's transaction options.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
29 July 2005

A handwritten signature in black ink, appearing to read "Vincent Millin".

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600